



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/597,501

07/27/2006

Takao Mori

SCH-16629

1984

40854 7590 08/22/2008

RANKIN, HILL & CLARK LLP

38210 Glenn Avenue

WILLOUGHBY, OH 44094-7808

EXAMINER

NGUYEN, THONG Q

ART UNIT

PAPER NUMBER

2872

MAIL DATE

DELIVERY MODE

08/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,501	Applicant(s) MORI, TAKAO	
	Examiner Thong Nguyen	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006 and 18 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/27/06 & 8/18/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Pre-Amendment

1. The present Office action is made in response to the Pre-amendments filed on 7/27/06 and 8/18/06. It is noted that in the pre-amendment of 7/27/06, applicant has made changes to the abstract and the claims, and in the pre-amendment of 8/18/06, applicant has filed a substitute specification with a marked-up copy showing the changes to the specification and a statement that the substitute specification does not contain any new matter. Regarding to the claims, applicant has amended claims 1-4. There is not any claim being added or canceled from the application.

Oath/Declaration

2. It is noted that while the oath or declaration does not provide the residence and the mailing address of the inventor; however, such information are provided in the Application Data Sheet filed by applicant on 7/27/06.

Drawings

3. The drawings contained three sheets of figures 1a-1d, 2a-2c, 3 and 4a-4c were received on 7/27/06. These drawings are objected by the examiner for the following reasons.

4. Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See present specification in paragraphs [0013] and [0030]. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the

page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The references "P" and N" as stated in the paragraph [0016] is not shown in at least one figure. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

6. A substitute specification without claims filed by applicant on 8/18/06 has been received by the Office and approved by the examiner.

7. The lengthy specification which was amended by the amendment of 8/18/06 has not been checked to the extent necessary to determine the presence of all possible

Art Unit: 2872

minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. The disclosure is objected to because of the following informalities: a) Paragraph [0001], on line 1, the terms thereof "Rigid endoscopes usually have an optical system" has a grammatical error. Should the mentioned terms be changed to --Each of a rigid endoscope usually has an optical system-- or any other suitable terms to correct the grammatical error in the mentioned terms? b) Paragraph [0019], on lines 2-3, the sentence thereof "As can be seen...are used" is unclear. Should the sentence be changed to --As can be seen from Figs. 1a-1c, for all three lens sets 1a, 1b and 1c, there is exactly the same lens units are used--?; c) Paragraph [0023], on line 2, "with 1a" should be changed to --with those shown in figure 1a--; d) Paragraph [0026], on line 2, "Fig. 2" should be changed to --Figs. 2a-2b--; e) Paragraph [0028], on line 1, "Fig. 2" should be changed to --Figs. 2a-2c—and on line 2, "unit 1 shown in Fig. 1" should be changed to --unit 1a-1c shown in Figs. 1a-1c--. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

Claim Objections

9. Claim 1 is objected to because of the following informalities. Appropriate correction is required.

First, the feature thereof "the optical system" (line 1) lacks a proper antecedent basis. Should the term "the" in the mentioned feature be changed to --an--?

Second, the feature thereof “said relay set” (line 6) lacks a proper antecedent basis. Applicant should note that since the claim recites a plurality of relay sets, see lines 5-6 of the claim, thus it is unclear to which relay set applicant refers by “said relay set” (line 6). Should the terms “said relay set” (line 6) be changed to --one of said relay sets-- or other suitable terms to make the claim comply with the requirement of 35 USC 112, second paragraph?

Third, the terms “the refractive powers Positive, Negative, Positive, Positive (P, N, P, P)” (lines 11-12) should be changed to --the refractive powers of positive, negative, positive, and positive (P, N, P, P)--.

Claim Rejections - 35 USC § 112

10. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 3 is rejected under 35 USC 112, first paragraph because the specification does not disclose a relay set having two half set wherein each half set consists of four lens units arranged *both in a symmetrical sequence with respect to the center of the set, see claim 1, lines 6-8, and each of half set comprises two outermost lens units arranged*

Art Unit: 2872

at asymmetrical distances from the center, see claim 3, lines 2-3. (Examiner's emphasis).

Applicant is respectfully invited to review the specification, in particular, pages 6-7 and figures. 2 in which the specification discloses a plurality of relay sets in which the lens units of the set are arranged in a symmetrical manner with respect to the center of the set. See figure 2a. In other embodiments, the specification discloses that the outermost lens units are arranged at asymmetrical distances from the center of the set, see figures 2b and 2c. Thus, the specification does not disclose any embodiment in which the lens units are arranged both in a symmetrical sequence with respect to the center of the set and the two outermost lens units are arranged at asymmetrical distances from the center as claimed.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 1-2, as best as understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Ibe (Japanese reference No. 10-73762, submitted by applicant).

Ibe discloses a rigid endoscope. The endoscope as described in paragraphs [0022] and shown in fig. 4 comprises the following features: a) an objective lens system (1), an eyepiece lens system(4), and a plurality of relay lens units (3) disposed between the objective lens system and the eyepiece lens system; b)

Art Unit: 2872

regarding to the structure of each of the relay lens unit (3), in paragraph [0030] and shown in fig. 4, each relay lens unit comprises two half sets arranged symmetrical with respect to each other about a center of the relay lens unit wherein each half set comprises a first positive lens, a second negative lens, a third positive lens and a fourth positive lens arranged in that order from the center of the relay lens unit. It is noted that each pairs of corresponding lens elements are arranged at symmetrical distances from the center of the relay lens unit. See optical data as provided in paragraph [0030].

Allowable Subject Matter

14. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

15. The following is a statement of reasons for the indication of allowable subject matter:

The relay set as recited in dependent claim 4 is patentable with respect to the prior art, in particular, the Japanese reference No. 10-73762 and the U.S. Patent Nos. 6,490,085 and 4,575,195 by the limitations related to the glass rod disposed in the gap between two half sets of lens. It is noted that while a relay lens unit comprises two half sets of similar lens elements arranged in a symmetric manner with respect to each other about a center of the relay lens unit is disclosed in the mentioned references; however, the cited art does not disclose a glass rod in the gap defined by the two half sets. It is noted that while the use of a glass rod

Art Unit: 2872

between two lens elements is disclosed in the Patent No. 4,575,195; however, the Patent does not disclose the structure of the relay lens unit as recited in the independent claim 1 in which claim 3 depends.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong Nguyen/

Primary Examiner, Art Unit 2872